

REMARKS

This is a response to the Office Action dated November 10, 2004. Claims 1-19 are pending in the application. Claims 1-10 and 12-19 stand rejected. Claim 11 is objected to.

Summary of Examiner's Action and Response

FIG. 5 was objected to on the grounds that it should properly be labeled "Prior Art" since only that which is old is illustrated. Applicant has attached a corrected drawing in compliance with 37 CFR 1.121(d).

Claims 1, 2, 5, 6, 8, and 17-19 were objected to based on several informalities. The claims have been amended, and Applicant now believes the claims are corrected.

The Examiner rejected Claims 1 and 6 under 35 U.S.C. §102(b), as being as being anticipated by U.S. Patent No. 3,547,488 to Barnes. Claims 1 and 6 have been amended and Applicant believes the claims are now in condition for allowance.

The Examiner rejected Claims 1, 6, and 17 under 35 U.S.C. §102(b), as being as being anticipated by U.S. Patent No. 5,490,710 to Dearing et al. Claim 17 has been amended and Applicant believes the claim is now in condition for allowance.

The Examiner rejected Claims 2, 4, 7, 9, and 18 under 35 U.S.C. §103(a) as being unpatentable over Dearing et al. in view of Lauzon et al. (U.S. 6,347,771). The Applicant has reviewed these prior art references, and the rejection is respectfully traversed.

The Examiner rejected Claims 3, 5, 8, and 19 under 35 U.S.C. §103(a) as being unpatentable over Dearing et al. in view of Lauzon et al. and further in view of Thomsen (U.S. 5,335,888). The Applicant has reviewed these prior art references, and the rejection is respectfully traversed.

The Examiner rejected Claims 10 and 12-16 under 35 U.S.C. §103(a) as being unpatentable over Dearing et al., as modified, in view of Thomsen and further in view of Artsvelyan (U.S. 6,578,914). The Applicant has reviewed these prior art references, and the rejection is respectfully traversed.

Response to Rejection of Claims 1, 6, and 17 under 35 U.S.C §102(b)

The Examiner rejected Claims 1 and 6 under 35 U.S.C. §102(b), as being as being anticipated by U.S. Patent No. 3,547,488 to Barnes and Claims 1, 6, and 17 under 35 U.S.C. §102(b), as being as being anticipated by U.S. Patent No. 5,490,710 to Dearing et al. Applicant has amended claims 1 and 6 to recite further limitations.

In order for a section 102(b) reference to be valid as prior art, every element and limitation of the claimed present invention - as literally defined in the claims - must be disclosed within the piece of prior art. *Jamesbury Corp. v. Litton Indus. Products*, 756 F.2d 1556, 225 USPQ 253 (Fed.Cir. 1985); *Atlas Powder Company v. du Pont*, 750 F.2d 1569 (Fed.Cir. 1984); *American Hospital Supply v. Travenol Labs*, 745 F.2d 1 (Fed.Cir. 1984). The Applicant respectfully submits that this requirement has not been met in view of amended claim 1, and that the section 102(b) rejection should therefore be removed.

Looking at U.S. Patent No. 3,547,488 to Barnes and U.S. Patent No. 5,490,710 to Dearing et al. neither patent teaches the limitation “wherein said arm rest cover opens into a forearm channel shaped to receive a forearm of said user.”

Response to 35 U.S.C §103 Rejections

The Examiner rejected Claims 2, 4, 7, 9, and 18 under 35 U.S.C. §103(a) as being unpatentable over Dearing et al. in view of Lauzon et al. (U.S. 6,347,771). The Examiner rejected Claims 3, 5, 8, and 19 under 35 U.S.C. §103(a) as being unpatentable over Dearing et al. in view of Lauzon et al. and further in view of Thomsen (U.S. 5,335,888). The Examiner rejected Claims 10 and 12-16 under 35 U.S.C. §103(a) as being unpatentable over Dearing et al., as modified, in view of Thomsen and further in view of Artsvelyan (U.S. 6,578,914). The Applicant respectfully submits that application of section 103 is improper in this case.

It is axiomatic that the prior art to be considered under section 103 must be analyzed in the absence of any teaching from the claimed invention. Such an evaluation requires the often difficult task of excluding anything taught or suggested by the present invention from one's mind. *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861 (Fed.Cir.1985).

In the abstract, this proposition is straightforward. However, courts have often struggled in applying it to relatively simple inventions. This is true because a relatively simple invention - once revealed by its creator - is easily understood. Thereafter, one is prone "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed.Cir. 983).

The United States Court of Appeals for the Federal Circuit recently discussed this issue in the case of *In Re Dembiczak*, 175 F.3d 994 (Fed.Cir. 2000), *limited on other grounds by In Re Gartside*, 203 F.3d 1305 (Fed.Cir.2000). *Dembiczak* involved a patent claim on the now-familiar orange trash bags with the printed Jack-O-Lantern faces.

The Dembiczak patent application was rejected by the U.S.P.T.O., then rejected by the Board of Patent Appeals and Interferences. In reversing these decisions, the Federal Circuit noted that

“[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *Id.* at 999.

The evidence of a suggestion, teaching, or motivation to combine prior art references must be established in order to set forth a prima facie case of obviousness. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 (Fed.Cir.1985). This evidence must come from the prior art references themselves, the knowledge of one who is skilled in the art, or from the suggestions inherent in the nature of a problem to be solved. *ProMold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed.Cir.1996). The suggestion of combination generally comes from the teachings within the references themselves. *In Re Rouffet*, 149 F.3d 1350, 1359 (Fed.Cir.1998).

The Applicant respectfully submits that the requirements for a prima facie case of obviousness have not been established in this case. Instead, the Applicant suggests that the P.T.O has fallen into the trap the *Dembiczak* opinion warns so sternly against - that of using the inventor's own disclosure to suggest combinations in order to defeat patentability. With the cited authority in mind, the application of section 103 to the various claims will now be discussed in detail.

Lauzon et al. and Dearing et. al.

Applicant has reviewed these prior art references and has found no teaching in either patent that supports the Examiner's combination of the prior art references. Lauzon et. al teaches a portable arm and mouse support that is designed to attach to a desk supporting a personal computer (see Lauzon et al.. FIG. 1 and Lauzon et al., column 1, lines 23-33). Applicant has found no teaching in either patent that suggests that the vertically offset mouse pad taught in Lauzon et al. could/should be attached to a

chair as recited in Applicant's claims. Absent such a showing, Applicant respectfully submits the combination of the references is improper.

Furthermore, affixing the vertically offset mouse pad taught in Lauzon et al. with the swing arm chair in Dearing et al. is inconsistent with the purposes and function of the invention in Lauzon et al. The Federal Circuit has held that a suggested modification to a reference which destroys the intent, purpose, or function of the invention disclosed in the reference (NOT the invention which forms the subject of the application) does not establish a case of prima facie obviousness. This is true because, in such a case, there would be no motivation to modify the prior art reference in the fashion proposed by the Examiner. *In re Gordon*, 733 F.2d 900 (Fed.Cir. 1984). As articulated in the patent to Lauzon et al., "it is therefore an object of the present invention to provide a portable arm and mouse support which includes a plurality of arm elements, the arm elements being rotatably connected to each other, to permit the portable arm and mouse support to be placed in a comfortable position for any user preference." (Lauzon et al., column 2, lines 56-61). By combining Lauzon's vertically offset mouse pad with Dearing's swing arm chair, such a goal cannot be realized. Without Lauzon's arm elements, the pad cannot be positioned in any user preference. Accordingly Lauzon teaches away from making the combination because it would defeat one of the stated objects of the invention.

In addition, a prior art reference does not create a case of prima facie obviousness if it fails to disclose a material element or limitation claimed in the present invention. *In re Evanega*, 829 F.2d 1110 (Fed. Cir. 1987). Applicant respectfully submits that the prior art does not include all material elements of limitations claimed in the present invention. Neither of the two cited patents disclose the newly added limitation which requires that the "arm rest cover opens into a forearm channel shaped to receive a forearm of said user."

Also, specifically in regards to claims 4 and 9, neither of the patents teach the limitation “wherein said table is inclined with respect to said arm rest cover.” Although Lauzon teaches a vertically offset mouse pad, the pad is parallel with respect to the arm rest (see Lauzon et al. FIG. 3). This is not the same as the limitation recited in claim 4 which requires the table to be inclined with respect to the arm rest cover.

Dearing et al., Lauzon et al. and Thomsen

Applicant incorporates the above mentioned arguments with regards to the combination of the Dearing et al. and Lauzon et al. patents. In addition, Applicant has reviewed the prior art reference to Thomsen and can find no teaching that supports its combination with Dearing or Lauzon. Specifically, it is not shown anywhere in the three patents that Thomsen’s forearm support cradle could/should be combined with the swing arm chair of Dearing or the portable arm and mouse support of Lauzon. Without the requisite showing of a teaching to combine the references, Applicant respectfully submits that combining the prior art references to make an obviousness rejection is improper.

In addition, combining the references is inconsistent with the stated purposes and functions of Thomsen’s invention. Applicant respectfully reminds the Examiner of the holding in *In re Gordon*, 733 F.2d 900 (Fed.Cir. 1984) which provides that a suggested modification to a reference which destroys the intent, purpose, or function of the invention disclosed in the reference does not establish a case of prima facie obviousness. Thomsen teaches that it is “a principal object” of Thomsen’s invention “to provide a new and improved ergonomic support for a computer mouse operator for supporting the operator’s forearm *while the operator’s hand and forearm are moved across the work surface* to operate a computer mouse.” (Thomsen, column 1, lines 28-34, emphasis added). To help accomplish

this goal, Thomsen teaches the use of straps (40, 42) which secure the support cradle to the user's forearm (FIG. 7). It would therefore be inconsistent with Thomsen's stated goals and purposes to permanently affix the support to a somewhat stationary arm rest cover, thereby preventing it from moving across the work surface.

Specifically with regards to claim 5, none of the three patents disclose the limitation "wherein said table is inclined with respect to said arm rest cover." Accordingly, the requirement that all material limitations be present in the references is not met.

Dearing et al., Thomsen, and Artsvelyan

Applicant incorporates the above mentioned arguments with regards to the combination of the Dearing et al. and Thomsen patents. Applicant has also reviewed the patent to Artsvelyan and can find no teaching to combine it with the patents to Dearing and Thomsen. Specifically, there is no teaching that the fastening device which is used to attach the cushion in Artsvelyan could be used to mount a pivotally adjustable table as recited in Applicant's claims.

Artsvelyan actually teaches away from making the combination by stating that the purpose of the invention is "to provide an armrest cushion that has cushion support and flexibility without losing the necessary rigidity to provide adequate support to the users. It is also desirable to provide an armrest cushion that allows users to adjust the cushion to apply to arms of various sizes and shapes." (Artsvelyan, column 1, lines 42-48). In other words, the cushion is designed to fit arms rests of various sizes; the fasteners are not designed to accommodate arm supports of various styles as implied by the Examiner. Artsvelyan's stated goal is to provide *cushioned support*. There is no teaching in Artsvelyan that supports the use of the fasteners to support a pivotally adjustable table. Accordingly,

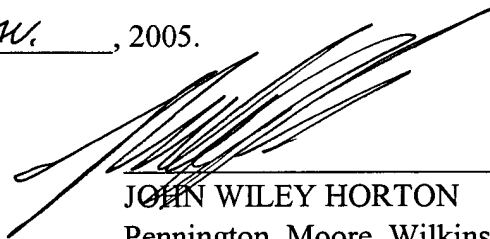
Applicant respectfully submits that the requisite showing of a teaching to combine references is not present, and that using straps similar to those employed by Artsvelyan for non-cushioned support is inconsistent with Artsvelyan's stated goals and purposes.

Specifically with regards to claim 14, none of the prior art references teach the limitation present in claim 4 (from which claim 14 depends) which provides "wherein said table is inclined with respect to said arm rest cover."

Conclusion

In view of the above amendments and remarks, the Applicant believes that the claims are in condition for allowance. Accordingly, the Applicant respectfully requests that the Examiner reconsider the rejections.

Respectfully submitted this 3rd day of JAN., 2005.



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